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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,269	08/01/2001	Jean-Louis Valadier	032326-143	5181

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EXAMINER

LEE, DIANE I

ART UNIT PAPER NUMBER

2876

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,269

Applicant(s)

VALADIER, JEAN-LOUIS

Examiner

D. I. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 06 December 2003. Claim 10 has been amended to correct the typographical error in the previous amendment, and no new claims have been newly added. Currently, claims 1-12 are remain pending in this application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-8, 10-12 are remain rejected under 35 U.S.C. 103(a) as being unpatentable over Benhammou et al. [US 6,094,724-referred as Benhammou].**

Re claims 1 and 12: Benhammou teaches a method of controlling the user of a smart card that executes cryptography calculations in the card for effecting authentication sessions that includes a user's identity session at the time of the a transaction between the card and a terminal (see the abstract), and at least one control counter, wherein one unit of the one control counter is set to 1 bit (an Authentication Attempts Counter (AAC) that incrementing the counter each time the authentication protocol is run, a Password Attempts Counter (PAC) that incrementing the counter each presentation of a valid security code), comprising:

incrementing the control counter by one unit at the start of a transaction comprising at least one authentication session by the card, i.e., the control counter is incremented by 1 bit serves as the counter incrementing by one unit (see col. 1, lines 59+; col. 3, lines 54+; and col. 5, lines 45+);

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subsequently decrementing the control counter by said unit (i.e., the control counter is reset to zero unit) if the authentication by the card has succeeded, e.g., the number in the counter is decrease to zero bit.

Benhammou does not teach that the controlling the counter is executed by microprocessor of the card.

The fact that controlling the counter is performed by the authentication unit 16 and password verification 20 of the card, the authentication unit 16 and password verification 20 performs equivalent function of applicant's claimed microprocessor. Furthermore, the recitation of microprocessor that executes cryptography calculation in the card has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Re claims 2 and 10: wherein the control counter counts up to a blocking value (i.e., eight attempts), the authentication session blocks the use of the associated key (see col. 4, lines 54+ and col. 5, lines 45+);

Re claim 3: the smart card implementing at least one encrypting key (see col. 6, lines 60+ and figure 4);

Re claim 4: wherein the blocking value associated with a counter is a function of the transaction in which an associated key is used (see col. 6, lines 60+ and figure 4);

Re claim 5, 7: wherein the incrementing unit of a control counter represents the number of cryptographic calculations with an associated key performed up till then and including the one consisting of the authentication session during the transaction (see col. 6, lines 60+ and figure 4);

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Re claims 6 and 8: wherein the control counter associated with a key is incremented by the unit at the initialization phase before each of the cryptographic calculation using the key up to and including the one relating to the authentication session by the card (see col. 6, lines 60+ and figure 4).

Re claim 11: if after eight attempts the password comparison is unsuccessful, the device becomes completely locked and cannot be accessed, therefore, the blocking of the use of the key is irreversible.

4. **Claim 9 is remain rejected under 35 U.S.C. 103(a) as being unpatentable over Benhammou in view of Admitted Prior Art by the Applicant (APA).** The teachings of Benhammou have been discussed above.

Benhammou does not expressly teach the authentication session by the card is effected at the time a connection by direct link to a server.

APA states that during the transaction mode of the terminal, the terminal is connected to a bank server, which effected at the time of a connection by direct link to a server (see page 1, lines 8+) and wherein the authentication session by the card is part of the transaction mode.

In view of APA's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to recognize that for performing an on-line transaction, the authentication session of Benhammou is obviously effected at the time a connection by direct link to a server.

Response to Arguments

5. Applicant's arguments filed 16 December 2003 have been fully considered but they are not persuasive.

6. Applicant argued on page 5, lines 15+ with respect to the claimed steps, in claim 1, of decrementing or incrementing the control counter by one unit at the start of a transaction comprising at

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least one authentication session by the card and if the authentication by the car is successful, subsequently incrementing or decrementing the control by one unit. Applicant further argued that Benhammou fails to disclose or suggest that the ACC decremented by a unit if the authentication protocol is successful as claimed. It is noted that the features upon which applicant relies (i.e., *subsequently incrementing or decrementing said control counter by one unit if the authentication by the card has succeeded*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Behhammou teaches the counter incrementing one unit for each time the authentication protocol is run. The counter is an eight bit counter that increment to 1 bit for each time the authentication protocol is run, i.e., one unit is equivalent to 1 bit, at the start of a transaction. Further, Behhammou teaches the eight bit counter is decremented by a predetermined unit, which is in this case the eight-bit counter is set to zero, if the authentication protocol is successful. Thus, the eight bit counter resetting to zero clearly teaches the counter decrementing step if the authentication protocol is successful.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is (571) 272-2399. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. I. Lee
Primary Examiner
Art Unit 2876

D. L.